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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,728	03/15/2001	Steve Hanks	249768043US	5675

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,728

Applicant(s)

HANKS ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. **Claims 1-8 and 10-15 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a

concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

3. Claims 17-37 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

Claims to processes that do nothing more than solve mathematical problems or manipulate abstract ideas or concepts are more complex to analyze and are addressed below. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

4. Claim 38 is rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The Applicant is claiming data structures. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute “descriptive material.” *Abstract ideas*, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or

the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive

material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-8, 10-15, and 17-37 are rejected under 35 USC 103(a) as being unpatentable over Amazon.com (a collection of prior art cited in PTO-892, Items: U-X), in view of Fast50 (a collection of prior art cited in PTO-892, Items: UU-V).**

Amazon.com teaches a merchant web site that provides sales ranking on a periodic basis, and hourly updating of 100 hot books and top selling videos to influence interest. Amazon.com further teaches:

- Determining a sales ranking: Amazon.com web merchant site shows a sales rank based on how well a book is selling compared with all current Amazon.com offerings; periodically updating (please note examiner's interpretation: a plurality of time periods) the web site to reflect improving sales (e.g. former rank was 79,400 and current rank is now 59,350); lower the number means more books sold (U: see at least page 1); hourly updating of top 100 hot books on merchant web site (V: see at least page 1; W: see at least page 1; X: see at least page 2).
- Selecting items having a current rank value this is less than a rank value threshold: displays the top 3 ranked 100 hot sellers for selecting (V: see page 2) (please note examiner's interpretation: rank threshold as displayed is equal to or less than 3, or rank threshold is less than 4).
- Identifying the largest rank value: displaying largest rank value of a selected item (e.g. 1,198,046) (U: see at least page 1).

- Determining a score:

Amazon.com teaches all the above as noted under the 103(a) rejection and teaches displaying rank value to influence interest, but does not disclose scoring. Fast50 teaches Washington Technology's web site displaying its FAST 50 listing of the top 50 fastest growing technology companies in the Washington region (VV: see at least page 4-7). Fast50 teaches the technology newspapers rankings being based on revenue growth (UU: see at least pages 1-2). Fast50 further teaches determining a score based on the growth over the 5-year period. For instance, Vistrionix was ranked #1 in FAST 50 1999 with a score of 14,484% growth whereas Management Applications received a score of 9,515%. Score was determined by the following equation: $((B-A)/A) \times 100\%$. Plugging in the numbers for Vistrionix where B= \$11,000,000; A=\$75,425: $((11,000,000-75,425)/75,425) \times 100\% = 14,484\%$. Vistrionix's ranking for 1998 was #7 (UU: see page 2, based on percentage change in revenue from 1993 to 1997). (Please note examiner's interpretation: publishing FAST 50 companies, profiles, and companies issuing press releases regarding FAST 50 their selection to the list generates marketplace interest). Therefore it would have been obvious to one of ordinary skill in the art to determine a score as taught by Fast50, in order to assign a rank value based on percentage growth, and thereby draw attention and interest to the merchant item.

Amazon.com and Fast50 teach all the above as noted under the 103(a) rejection and teach a) Amazon.com dynamically updating an item's rank based on sales compared to total items sold over a period of time, b) Amazon.com displaying a former rank and a current rank, and c) Fast50 determining and displaying a scoring based on percentage growth over a period of time using the equation $((B-A)/A) \times 100\%$, but do not specifically disclose determining score based on percentage of ranking growth. It would have been obvious to one of ordinary skill in the art at time of the invention to determine and display scores based on percentage of ranking growth, since one of ordinary skill in the art at time of the invention would ascertain scoring and displaying based on $((B-A)/A) \times 100\%$.

6. **Claims 9, 16, and 38 are rejected under 35 USC 103(a) as being unpatentable over Amazon.com (a collection of prior art cited in PTO-892, Items: U-X), in view of Fast50 (a collection of prior art cited in PTO-892, Items: UU-V), further in view of Official Notice (regarding computer readable medium).**

Amazon.com teaches a merchant web site that provides sales ranking on a periodic basis, and hourly updating of 100 hot books and top selling videos to influence interest. Amazon.com further teaches:

- Determining a sales ranking: Amazon.com web merchant site shows a sales rank based on how well a book is selling compared with all current Amazon.com offerings; periodically updating (please note examiner's

interpretation: a plurality of time periods) the web site to reflect improving sales (e.g. former rank was 79,400 and current rank is now 59,350); lower the number means more books sold (U: see at least page 1); hourly updating of top 100 hot books on merchant web site (V: see at least page 1; W: see at least page 1; X: see at least page 2).

- Selecting items having a current rank value this is less than a rank value threshold: displays the top 3 ranked 100 hot sellers for selecting (V: see page 2) (please note examiner's interpretation: rank threshold as displayed is equal to or less than 3, or rank threshold is less than 4).
- Identifying the largest rank value: displaying largest rank value of a selected item (e.g. 1,198,046) (U: see at least page 1).
- Determining a score:

Amazon.com teaches all the above as noted under the 103(a) rejection and teaches displaying rank value to influence interest, but does not disclose scoring. Fast50 teaches Washington Technology's web site displaying its FAST 50 listing of the top 50 fastest growing technology companies in the Washington region (VV: see at least page 4-7). Fast50 teaches the technology newspapers rankings being based on revenue growth (UU: see at least pages 1-2). Fast50 further teaches determining a score based on the growth over the 5-year period. For instance, Vistronix was ranked #1 in FAST 50 1999 with a score of 14,484% growth whereas Management Applications received a score of 9,515%. Score was determined by the following equation: $((B-A)/A) \times 100\%$. Plugging in the

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numbers for Vistronix where $B = \$11,000,000$; $A = \$75,425$: $((11,000,000 - 75,425) / 75,425) \times 100\% = 14,484\%$. Vistronix's ranking for 1998 was #7 (UU: see page 2, based on percentage change in revenue from 1993 to 1997). (Please note examiner's interpretation: publishing FAST 50 companies, profiles, and companies issuing press releases regarding FAST 50 their selection to the list generates marketplace interest).

Therefore it would have been obvious to one of ordinary skill in the art to determine a score as taught by Fast50, in order to assign a rank value based on percentage growth, and thereby draw attention and interest to the merchant item.

Amazon.com and Fast50 teach all the above as noted under the 103(a) rejection and teach a) Amazon.com dynamically updating an item's rank based on sales compared to total items sold over a period of time, b) Amazon.com displaying a former rank and a current rank, and c) Fast50 determining and displaying a scoring based on percentage growth over a period of time using the equation $((B-A)/A) \times 100\%$, but do not specifically disclose determining score based on percentage of ranking growth. It would have been obvious to one of ordinary skill in the art at time of the invention to determine and display scores based on percentage of ranking growth, since one of ordinary skill in the art at time of the invention would ascertain scoring and displaying based on $((B-A)/A) \times 100\%$.

Amazon.com and Fast50 teach all the above as noted under the 103(a) rejection and teach web pages served to a web browser. The examiner takes the

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position that it is old and well-known in the arts that networked computers serve web pages to web browsers and that computers require computer readable memory medium for program and data storage. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose computer readable medium as taught by Official Notice, in order to more fully convey structural components of a computer-based system.

Pertaining to system Claim 16

Rejection of Claim 16 is based on the same rationale as noted above.

Pertaining to data structure Claim 38

Rejection of Claim 38 is based on the same rationale as noted above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Tanaka, Jenifer; "The Web's Best Friends," Newsweek, 13 March 200, v135n11pg70; Proquest #50847931, 3pgs; teaches Quiver.com ranking web sites on a daily basis; motivating users to follow the crowd; Amazon.com.
- US 2002/0004751 (Seiki et al.) 10 January 2002; teaches a product retail sales management server using current prices, price trends, retails sales history, and ranking data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

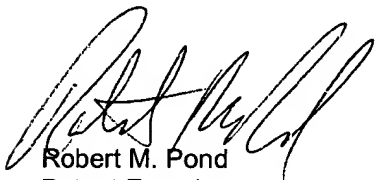
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Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read "Robert M. Pond", is written over the printed name.

Robert M. Pond
Patent Examiner
August 9, 2004